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Response (cont).

REMARKS- General

Reference is made to the interview of July 6, 2004, in which the invention was demonstrated to the Examiner. At this meeting, ways in which the claims could be amended to be more definite were discussed. The amendments of this response are based on that discussion.

In the September 8, 2004 rejection under 35 U.S.C. 103(a) of the original claims, the Examiner cited Powell, Kierman, Bennett and Astiz as prior art. The Examiner's primary objection to the previous independent claim was that following a hyperlink from a table of contents such as that shown in Powell, causing the linked text to be displayed, could be construed as meeting the original independent claim. While the Examiner rejected dependent claims 2-13, 15-17, and 19-20, claims 14 and 18 were objected to as being dependent upon a rejected base claim. According to the Office Action, claims 14 and 18 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

In response, although disagreeing with the USPTO's rejection of the independent claims, in an effort to speed prosecution and simplify the evaluation of the present application, and in reliance on the USPTO's statement that claims 14 and 18 would be allowable if rewritten in independent form, the Applicant cancelled the previous claims, and introduced new claims 23-44. These new claims were based solely on the USPTO's conclusion with respect to original claim 14, and simply involved the re-writing of this claim in independent form. However, after submission of this amendment, in the USPTO's August 10, 2005 office action, the Examiner introduced a new argument and new prior art, now objecting only to new claims 32 and 33, but rejecting all other claims, including claim 23 (the rewritten original claim 14) that formed the basis for this amendment.

Because it was the Applicant's original intent to pursue the claims in original claims 1-22, and the Applicant was diverted from this purpose only by the USPTO's representation regarding the patentability of original claim 14, in the present response, the Applicant would like to address the USPTO's rejection of original claims 1-22. In so doing, the Applicant has reinstated claims 1-22, and amended the original independent claims to be more definite and to more clearly show the correspondence of outline elements and the portions of text that they represent, and to clearly exclude the possibility that following a hyperlink to permit display of hyperlinked text could be construed as an example of the invention. When a user indicates an outline element, the corresponding text is selected, and the selected text is provided as the input for a non-display operation. The references cited by the Examiner do not provide this functionality, either alone or in combination.

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Thus, Powell does not teach or suggest the material of amended claim 1, in which it is now clear that display of text referred to by an outline element does not meet the criteria for an operation of step (c).

The following arguments apply to the Examiner's September 8, 2004 rejections of the original dependent claims, in anticipation of the possibility that similar arguments might be considered in the context of the current amendment.

Original claim 3 was rejected based on Powell, in which clicking on a table of contents entry changed the browser window to display the text referred to by that table of contents entry. However, according to original (and also amended) claim 3, the results of the operation must be displayed *on the outline*, a limitation that clearly is not met by Powell. Moreover, based on amended claim 1, it is clear that display of the text does not meet the criteria for the operation of step (c).

With respect to original claim 7, Powell does not demonstrate the claimed functionality, since clicking on table of contents elements in Powell causes the table of contents to disappear completely. Moreover, according to claim 7 (both originally and as amended), as the cursor location in the original text moves, the portion of the outline that is simultaneously displayed corresponds to that text which is displayed. Powell provides no means to simultaneously display an outline and the corresponding original text, and to assure that the displayed portion of the outline corresponds to the text that is denoted by the cursor location at any given time.

With respect to original claim 8, which was dependent on original claim 3, the contents of the outline cannot be construed as a result displayed on the outline. Since it is clear that Powell does not display any results of operations on the outline, displaying the text referred to by an outline element is not the same as providing a link as part of the result of an operation. Any links present in the outline of Powell were integral parts of the outline, and were there prior to any operations. These arguments also apply to amended claim 8.

With respect to original claim 9, contrary to the Office Action's characterization (9/8/04 O.A. page 7), the term "reverse indexing" does not refer to placing an index in reverse alphabetical order, but is described in some detail in the specification (e.g., pp 74-75). Powell does not provide reverse indexing, and no motivation is provided for providing a "reverse index" in the context of Powell, which merely provides a link from a table of contents into the text. Claim 9 is now amended to include a definition of reverse indexing.

With respect to original claim 11, following a hyperlink clearly does not constitute a search, as implied in the 9/8/04 O.A. (p.7). In the 9/8/04 O.A., the USPTO does not explain how Powell discloses any searches, or selection of any material for search. Clicking on a title in the table of contents, and displaying that page, is not the same as providing a method for a portion of electronic text to be selected

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for searching based on indicating that material on an outline, as claimed in original and amended claim 11.

With respect to original claims 12 and 13, the USPTO (9/8/04 O.A. pp. 7-8) asserts that it would have been obvious to modify Powell to include printing and copying features, based on the ability of a user of a text to manually select and highlight any portion of a text, and subsequently use that text for printing or copying. However, this is different from indicating an element on the outline and through the practice of the invention causing the entire section of text referred to by that outline element to be selected for a subsequent operation like printing or copying. Amended claim 1, on which claims 12 and 13 depend, makes it clear that the invention does not involve the manual selection of text.

With respect to original claims 15 and 16, the USPTO (9/8/04 O.A. pp. 10-11) asserts that Astiz could be combined into Powell to provide the ability to identify additional material related to that referred to by the outline element. However, amended claims 1, 15, and 16 make clear that simply providing related material (as Astiz does) is not sufficient—to meet claims 15 or 16, indicating an outline element would need to first cause the entire text represented by that outline element to be selected, and then would require an operation to be performed on that text, in which the outcome of that operation would be the identification of related material. In the case of Astiz, no such selection or operation on the selected text is performed.

Original claim 17 was rejected based on the combination of Powell and Bennett. Col. 18, lines 22-37 of Bennett refer to Figure 5f, in which the capability of entering annotations related to documents stored in an outline structure is provided. However, amended claims 17 and 1 (on which claim 17 depends) make clear that simply storing annotations within an outline structure (as Bennett does) is not sufficient—to meet claim 17, indicating an outline element would need to first cause the entire text represented by that outline element to be selected, and then would require an operation to be performed on that text, in which the outcome of that operation would be the identification of annotations to the selected text. In the case of Bennett, no such selection or operation on the selected text is performed—annotations are identified based solely on their relationship to the outline, rather than to the underlying text.

With respect to original claim 20, although the outline of Powell includes text from the linked material, no operation in response to the indication of an outline element, that causes the partial display of text on the outline, is described. Any text presented as a part of the outline in Powell was present prior to any operation—thus; the display of text on the outline cannot be the result of an operation. Thus, Powell does not meet the limitations of claim 20, as asserted in the 9/8/04 O.A. (page 8), and also does not meet the limitation of amended claim 20.

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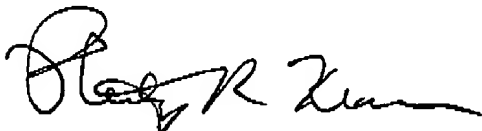
Response (cont).

The dependent claims have also been amended to more clearly show their relationship to the amended independent claims and to correct errors in language.

Conclusion

The applicant submits that the amended claims are proper, definite, and define novel structure which is also unobvious. The applicant further submits that this application is now in condition for allowance, which action he respectfully solicits.

Very Respectfully,



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Date: 10 November 2005

Certificate of Facsimile Transmission

I certify that on the date below, I will fax this communication and attachments, if any, to Group 2178 of the Patent and Trademark Office at the following number: 571-273-4125.

Date: 10 November 2005

Inventor's signature: _____

